

Serial No. 10/054,447

PATENT
Attorney Docket: P9170.00REMARKS

The examiner has taken the position that further restriction of the pending claims is required under 35 U.S.C. 121. The examiner states that the application contains claims directed to the following multiple inventions:

- I. Claims 1-10, 233 and 273-281, drawn to a coated medical device and method of coating a hydrophilic polymer on a surface of a medical device, wherein the medical device has a catechol moiety disposed on the surface of the device and the hydrophilic polymer comprises a guanidino moiety, classified in class 424, subclass 422.
- II. Claims 52-61, 234 and 282-290, drawn to a coated medical device and method of coating a hydrophilic polymer on a surface of a medical device, wherein the medical device has a guanidino moiety disposed on the surface of the device and the hydrophilic polymer comprises a catechol moiety, classified in class 424, subclass 422.
- III. Claims 103-114, 235, 237-243, 246-249 and 291, drawn to a coated medical device and method of coating a biomolecule on a surface of a medical device, wherein the medical device has a hydrophilic polymer comprising a catechol moiety disposed on the surface of the device and the biomolecule comprises a guanidino moiety, classified in class 424, subclass 422.
- IV. Claims 162-173, 236, 255-261, 264-267 and 292, drawn to a coated medical device and method of coating a biomolecule on a surface of a medical device, wherein the medical device has a hydrophilic polymer comprising a guanidino moiety disposed on the surface of the device and the biomolecule comprises a catechol moiety, classified in class 424, subclass 422.

Serial No. 10/054,447

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Applicants respectfully traverse the restriction requirement. As an initial matter, Applicants note that the application has already undergone a lengthy and protracted prosecution, involving two initial restriction requirements, which were satisfactorily addressed by Applicants, followed by a first office action on the merits, which has now been followed with yet another restriction requirement. Applicants note that the MPEP requires that "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." MPEP 811. In order for the examiner to maintain restriction based on a statement of serious burden to the examiner, the examiner must show one of the following: (1) separate classification thereof, (2) separate status in the art when classifiable together, or (3) different field of search. MPEP 808.02.

Applicants submit that the examiner has not demonstrated a serious burden based on any of those three bases. Regarding basis (1), the examiner specifically notes that all four of the alleged multiple inventions fall in the same class and subclass (class 424/subclass 422). Therefore, no separate classification basis exists. Regarding basis (2), the examiner states that the alleged multiple inventions "have acquired a separate status in the art in view of their different classification," which as just noted, is not the case. Moreover, as stated in MPEP 808.02, an examiner can support restriction under basis (2) by showing "a recognition of separate inventive effort by inventors ...[or] by citing patents which are evidence of such separate status," neither of which have been done by the examiner in the office action. The examiner's statement that the alleged multiple inventions "have acquired a separate status in the art because of their recognized divergent subject matter" is wholly unsupported and belied by the examiner's placement of all four groups in the same class/subclass. Regarding basis (3), the examiner states that the alleged multiple inventions "require a different field of search (see MPEP 808.02)" but does not provide any support for that statement whatsoever (i.e., as suggested in MPEP 808.02 that different search queries were required, etc.). And in fact, that the examiner presumably already examined all of the pending claims when the examiner issued the previous office action on the merits, which rejected all of the pending claims over Ragheb et al., is a strong indication that

Serial No. 10/054,447

PATENT
Attorney Docket: P9170.00

all of the pending claims are indeed in the same field of search and were considered to be so by the examiner previously.

Finally, Applicants note that the examiner's statements that the alleged multiple inventions "are not capable of use together and they have materially different designs, modes of operation, functions and effects" and that the alleged multiple inventions are "independent and distinct" seem to be based on a misunderstanding of the nature of the invention. In particular, the examiner states that the placement of the various components of the invention (catechol, guanidino, polymer, biomolecule) "lend to different effects" and "effect whether they are released locally versus systemically and immediately versus sustained." However, the invention as presently claimed involves forming a chemical bond between the various components, and does not involve releasing any of those components. As noted in the summary of the invention, the "present invention includes within its scope methods for attaching hydrophilic polymers and/or biomolecules to biomaterial surfaces for use in medical devices." Specification page 9, lines 21-23 (emphasis added). Thus, the examiner's basis for asserting that the alleged multiple inventions are "independent and distinct" is incorrect.

Thus, as mandated by the MPEP, "[w]here ... the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. Applicants submit that this is exactly the situation here and the examiner has not provided any basis to the contrary. Applicants respectfully request that the restriction requirement be withdrawn and that all of the pending claims remain in the case.

Applicants further note that there is no discussion in the present office action of Ragheb et al., over which the examiner rejected the pending claims in the previous office action. Applicants submit that Applicants' Response and Amendment to that office action filed January 18, 2006 successfully removed that reference as applicable prior art. Thus, if the examiner withdraws the restriction requirement as argued by

Serial No. 10/054,447

PATENT
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Applicants above, Applicants submit that the claims are in condition for allowance and respectfully request that they proceed to issue.

Nevertheless, Applicants provisionally elect with traverse Group I, claims 1-10, 233 and 273-281, for continued prosecution. Applicants reserve the right to prosecute the non-elected claims, i.e., Group II, claims 52-61, 234 and 282-290; Group III, claims 103-114, 235, 237-243, 246-249 and 291; and Group IV, claims 162-173, 236, 255-261, 264-267 and 292, and file one or more future divisional applications.

The examiner is invited to contact Applicants' Representative at the telephone number provided below to discuss this Response and thereby advance substantive prosecution of the application.

Respectfully submitted for,
Keogh, et al.

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